

REMARKS/ARGUMENTS

By the present amendment, claims 25, 39, 41-45, 83 and 96-103 are canceled. Claims 92, 94 and 95 are currently amended. Claims 116-121 have been added. Claims 26-27, 29-38, 50-61 and 76-81 are currently withdrawn. Accordingly, claims 92-95 and 104-121 are currently pending.

With respect to the Examiners' rejection under 35 U.S.C. § 112, first paragraph at paragraph 3, pages 2-6, applicants hereby cancel claims 96-103. The Examiners indicated during the interview of October 17, 2006 that claim 92 is not technically rejected under 35 U.S.C. § 112, first paragraph, for enablement. Accordingly, applicants respectfully assert that the rejection under 35 U.S.C. § 112, first paragraph, is obviated by the present amendment. However, applicants do not acquiesce to any of the arguments asserted by the Examiner and hereby reserve the right to further assert such arguments in any further prosecution of this application and in any continuation, continuation-in-part or divisional application claiming priority to the present application.

Regarding the rejections under 35 U.S.C. §§ 102(b) and 102(e), the present amendment cancels claims 25, 39, 41-45, 74 and 83, thereby rendering the rejection moot. Again, although such claims are hereby canceled, applicants do not acquiesce to any of the arguments set forth by the Examiner, and hereby reserve the right to assert any and all arguments in any further prosecution, continuation, continuation-in-part or divisional application claiming priority to the present application.

With respect to the Examiner's rejection under 35 U.S.C. § 112, first paragraph, regarding new matter, the present amendment hereby cancels all claims that include the alleged new matter. Accordingly, applicants respectfully assert that the rejection should be withdrawn. However, applicants do not acquiesce to the new matter argument set forth by the Examiner, and specifically reserve the right to address this argument or similar arguments in any further prosecution, continuation, continuation-in-part or divisional application which claims priority to the present application. Furthermore, during the interview of October 17, 2006, the Examiner specifically indicated that claims 92-95 and 105-115 were not technically subject to the new matter

rejection. For this additional reason, applicants respectfully assert that the rejection should be withdrawn.

Concerning the rejection under 35 U.S.C. § 112, second paragraph, for claim 25 set forth in paragraph 7, page 14, of the Office Action, claim 25 is hereby canceled. Applicants respectfully request withdrawal of this rejection. Again, applicants do not acquiesce to the Examiner's argument and hereby reserve the right to assert this argument or similar arguments in any further prosecution, continuation, continuation-in-part or divisional application claiming priority to the present application.

With reference to the rejection of claims 92, 94 and 95 under 35 U.S.C. § 112, second paragraph, regarding the step of "preparing a Chlamydia psittaci antigen ...," applicants hereby amend claims 92, 94 and 95 to remove the preparing step as suggested by the Examiners during the interview of October 17, 2006. As asserted during the interview, applicants agree with the Examiners that in a method of immunizing, the antigen is already present and prepared. Furthermore, the antigen may be obtained and prepared in any of the manners disclosed in the specification, including preparing it synthetically, preparing it recombinantly, preparing it through expression library immunization (ELI) or isolating the antigens from a microorganism.

With regard to paragraphs 9-12 on pages 14-16 of the Office Action, by the present amendment, applicant has canceled claims 96-103, thereby obviating the rejection. Thus, applicant requests withdrawal of these rejections. However, applicants do not acquiesce to the arguments asserted by the Examiner and hereby reserve the right to submit such arguments in any further prosecution, continuation, continuation-in-part or divisional application that claims priority from the present application. Additionally, claim 107 was included in the rejection in paragraph 9 on page 14. Applicants respectfully assert that the subject matter of claim 107 is not relevant to the rejection made in paragraph 9, as claim 107 specifies the type of animal and the method of immunizing. Therefore, applicants respectfully request removal of the rejections in paragraphs 9-12 on pages 14-16 of the Office Action.

Concerning the rejection under paragraph 13, applicants respectfully assert that the amendments to claims 92, 94 and 95 obviate this rejection. Applicants respectfully request removal of this rejection.

Regarding the rejections under 35 U.S.C. § 112, second paragraph, in paragraphs 14 and 15, pages 16 and 17, of the Office Action, applicants respectfully assert that the timing of the administration is not essential to the method of immunizing. Applicants respectfully assert that the second administration may occur either subsequent or prior to the first administration (*see*, application at page 9, lines 17-19) or simultaneously with the first administration (*see*, application at page 7, lines 18-23). Accordingly, applicants have added new claims 116-121 that are directed to the timing of the second administration of an antigen relative to the first administration. Support for such claims are provided in the citations above. Applicants respectfully assert that the addition of new claims 116-121 obviate the rejection under 35 U.S.C. § 112, second paragraph, and, therefore, respectfully request removal of the rejection.

Regarding the Examiner's rejection under 35 U.S.C. § 102(a), applicant hereby submits full text of the poster set forth at the FASEB meetings held May 12-16, 2000 (*see*, Information Disclosure Statement submitted herewith).

First and foremost, applicant notes that this is a rejection under 35 U.S.C. § 102(a), which requires that the invention must be known or used by others to be considered prior art. The word "others" has been interpreted to mean anyone other than the applicant (*see*, In re Land, 368 F.2d 866, 151 USPQ 621, 630 (CCPA 1966)). Since the poster includes the same inventors as the present application, it cannot be "known or used by others."

More importantly, to the extent that the Examiner is attempting to establish a prima facie case of anticipation, applicants respectfully assert that the Kaltenboeck et al poster is not a single reference that teaches or enables each of the claimed elements expressly or inherently as interpreted by one of ordinary skill in the art. Most importantly, the claims are directed to particular amino acid sequences. The sequences are not taught by the poster and, therefore, are not taught nor enabled as required by

§ 102. The reference must generally place the subject matter supporting the anticipation rejection in the public domain before the date of the invention. This requires that the reference (1) disclose the claimed invention and (2) it must be available to the public, *see*, e.g., Innovative Scuba Concepts, Inc. v. Feder Industries, 819 F. Supp. 1487, 27 USPQ2d 1254, 1263 (D. Co. 1993) ("description by a prior publication occurs where the work adequately describes the invention in question.") Applicants respectfully assert that the reference does not disclose the amino acid sequences as set forth in the specific sequence ID numbers of the pending claims.

To the extent that the Examiner is relying on inherency, applicants respectfully assert that an inherency argument is insufficient to suggest that the claimed amino acid sequences are inherently disclosed by the Kaltenboeck poster. The reasoning behind inherency and its flexibility in the anticipation rejection is to accommodate situations "where the common knowledge of technologists is not recorded in the reference, that is, where technological facts are known to those in the field of the invention, albeit not to judges," Continental Can Company USA v. Monsanto Company, 938 F.2d 1264, 20 USPQ2d 1746, 1749-50 (Fed. Cir. 1991). Thus, inherency permits, in very limited circumstances, an invention to be anticipated by prior art that is lacking minor, well known features claimed in the application.

The specific amino acid sequences claimed in the present application are by no means minor details to the claimed subject matter. Much to the contrary, the claimed amino acid sequences are specific, unique features of the claimed invention and are by no means minor technological facts known to those in the field of the invention. Moreover, the CCPA has added that "inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing *may* result from a given set of circumstances is not sufficient," In re Oelrich, 666 F.2d, 578, 581, 212 USPQ 323, 326 (CCPA 1981). Thus, the missing element or function must necessarily result from the prior art reference. This is clearly not the case here. The Kaltenboeck poster is merely directed to a method for identifying candidate genes using a random expression library immunization technique. In fact, the Kaltenboeck poster does not even indicate that the

Application No. 10/023,437  
Reply to Office Action of July 28, 2006

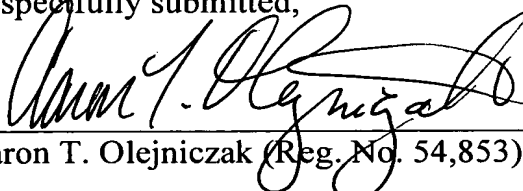
inserts included in the protective plasma is identified or ever sequenced. Moreover, there is no teaching or suggestion, whatsoever, that the specific sequences claimed in the present application have been identified by the disclosure of the Kaltenboeck poster.

Accordingly, applicant respectfully asserts that a prima facie case of anticipation is not established by the Kaltenboeck poster because the particular amino acid sequences claimed by the present application are not disclosed. As the Federal Circuit has cautioned, all claimed elements must be found in the prior art for anticipation to be found: "For a prior art reference to anticipate a claim, the reference must disclose each and every element of the claim with sufficient clarity to prove its existence in the prior art ... Although this disclosure requirement presupposes the knowledge of one skilled in the art of the claimed invention, that presumed knowledge does not grant a license to read into the prior art reference teachings that are not there," Motorola, Inc. v. Interdigital Tech Corp., 121 F.3d 1461, 43 USPQ2d 1481, 1490 (Fed. Cir. 1997). Accordingly, applicants respectfully request withdrawal of this rejection.

In conclusion, applicants respectfully assert that the present amendment places the claims in condition for allowance, and such action is respectfully solicited.

Applicants invite the Examiner to contact the undersigned with any questions, concerns or in any effort to move the case to allowance.

Respectfully submitted,



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